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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/280,609	03/29/1999	DAVID BARCK	6402	6090

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EXAMINER

WILLETT, STEPHAN F

ART UNIT PAPER NUMBER

2141

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/280,609

Applicant(s)

BARCK ET AL.

Examiner

Stephan F Willett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-23 and 41-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-23 and 41-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11-23, 41-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri with Patent Number 6,064,982 in view of Christeson et al. with Patent Number 5,926,817.

4. Regarding claim(s) 11, 13, 21-23, 44-45, 47-49, Puri teaches a product configuration system over a LAN. Puri teaches receiving on-line a desired selection not to mention all the other on-line data that can be obtained if it is desired to work on-line, col. 4, lines 19-21 that culminates "to enter an order" report which can be done online if desired. Puri teaches selection of a product as "the smart configurator provides interactive, off-line product selection dialog in which a matrix of company products is presented", col. 3, lines 54-56. Puri teaches downloading

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from the at least one server to the at least one client limited configuration information and limited configuration programs that is a subset based on said selected product as "various packaged options are available for selection and/or individual components may be selected", col. 5, lines 52-53, a limited configuration engine or interfaces or browser pages that merge user entered information, col. 2, lines 30-39, col. 3, lines 24-46 and col. 5, lines 1-15 as a "down load from a company Web page", col. 3, line 1 with "various modules comprise linked pages", col. 3, lines 38-39 and "for communicating with a remote location regarding same" col. 3, lines 48-49 then "thereafter, the transaction is complete", col. 4, line 21. Puri teaches requesting from the user on the at least one client a desired technical configuration and preliminarily checking at the client the viability of the desired technical configuration using the limited configuration information and the limited configuration programs as "the smart configurator determines the appropriate hardware requirements to run the software in an acceptable fashion", col. 3, lines 63-65, col. 2, lines 63-65 and a "technical support server", col. 2, line 54 to determine "options selections" "until the customer's needs are thoroughly and accurately accessed", col. 5, lines 14-15. Puri teaches uploading the desired technical configuration from the client to the at least one server and performing a full check on the viability of the desired technical configuration using full configuration information and full configuration programs on the at least one server as "the actual hardware requirements for particular software solution are automatically determined by the smart configurator", col. 5, lines 63-65, "the smart configurator may be optionally placed on-line to check for the existence of more current pricing and SKU information at a company server, etc.", col. 4, line 16-21, 28-33 and col. 6, lines 46-52. Puri teaches responsive to the full check, preparing and outputting on the at least one client an electronic order report as "the smart

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configurator provides a proposal template that merges various customer related information into a generic proposal", col. 6, lines 20-22. Puri teaches the invention in the above claim(s) except for explicitly teaching desired technical configurations. In that Puri operates to generate configuration fields, the artisan would have looked to the network configuration arts for details of implementing user selections. In that art, Christeson, a related network configuration system, teaches a "the same applies to changes to access types and service types", col. 4, lines 9-11 in order to provide versatility. Christeson specifically teaches that "once the representative has completed entering all required fields and has selected the appropriate optional fields" at col. 6, lines 36-37, and more specifically col. 12, lines 34-49. A user's selection of desired fields is possible and only viable alternatives are pursued. Further, Christeson suggests that "error messages are displayed with solutions", col. 4, lines 29 will result from implementing his system. The motivation to incorporate optional fields insures that only viable configurations are accepted. Thus, it would have been obvious to one of ordinary skill in the art to incorporate options viability as taught in Christeson into the configuration system described in Puri because Puri operates with selectable fields and Christeson suggests that optimization can be obtained with optional fields. Therefore, by the above rational, the above claims are rejected.

5. Regarding claims 12, Christeson teaches using a TCP/IP connection to pass an HTTP request from the client to the server as "such TCP/IP", col. 12, lines 14. Thus, the above claim limitations are obvious in view of the combination.

6. Regarding claims 14, 15, 16, 20, 46, 51, and 53, Puri teaches the limited configuration programs comprise an HTML page and client-side programs, the client-side programs comprise a plug-in or helper-application and the client-side programs include one or more programs

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selected from Java, JavaScript, ActiveX, and Helper-Viewer and CGIs as "dynamic HTML and JAVA script", col. 3, lines 13, and more specifically col. 12, lines 34-49.. Thus, the above claim limitations are obvious in view of the combination.

7. Regarding claims 17, 18, 19, 52, Christeson teaches the client-side programs are cached on the client, the client-side programs are cached in client-side memory and the client-side programs are cached in client-side disk storage as "removable storage unit, also called a program storage device or a computer program product, represents a floppy disk, magnetic tape, compact disk, etc.", col. 14, lines 19-22. Thus, the above claim limitations are obvious in view of the combination.

8. Regarding claim 41-43, 50, the Puri and Christeson patents discloses the method of the preceding claims. The Puri and Christeson patents do not explicitly disclose configurations relating to vehicles. However, Official Notice is taken MPEP 2144.03 (a) that vehicle configurations is well known in the art to insure a diverse product line. It would have been obvious to one of ordinary skill in the art at the time of the application's invention to configure a vehicle to obtain the advantages of a wider produce line as shown in Geller et al. with patent Number 6,300,948. By the above rational, the claim is rejected.

Response to Amendment

1. The broad claim language, i.e. limited configuration engine and technical configuration, used is interpreted on its face and based on this interpretation the claims have been rejected.

2. The limited structure claimed, without more functional language, reads on the references provided. The applicant has make good arguments to distinguish subsets of processing

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capability, however, Internet processing has enhanced this type of processing capability which is clearly done at the client or server and /or even changes the processing location depending on network loads. Thus, to further prosecution, it is suggested the types of configuration “viability” and types and differences of the checks described in the specification be further claimed. Thus, Applicant’s arguments can not be held as persuasive regarding patentability.

9. Applicant suggests “receiving a limited subset of all the functionality”, Paper No. 12, Page 5, lines 4 and “preliminary checked at the client” and “a full check ... on the server”, Paper No. 16, Page 9, lines 7-11. However, Puri teaches a “down load from a company Web page”, col. 3, line 1 with “various modules comprise linked pages”, col. 3, lines 38-39 which adds more software and data “for communicating with a remote location regarding same” col. 3, lines 48-49 then “thereafter, the transaction is complete”, col. 4, line 21. In addition, Puri teaches a “technical support server”, col. 2, line 54 to determine “options selections” “until the customer’s needs are thoroughly and accurately accessed”, col. 5, lines 14-15, thus preliminary and full checks are clearly taught. Clearly, the on-line capability allows further checking of the requested configuration that can be done at the client or server and these are not mutually exclusive since all the capability can not timely reside at the client. Applicant suggests “the updated information [from the server] is still processed on the client side”, paper dated June 30, 2004, page 8, lines 15-16, but such a limited reading is not reasonable or found in the reference. However, legacy processing, such as “product selection/configuration process”, col. 1, line 42 is well known to be done at a server as suggested by “each of these functions may reside within a tightly coupled company data processing system, i.e. on a mainframe [server]”, col. 2, lines 58-60. The references should not be read in a vacuum, the teachings are not mutually exclusive, and

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must be taken in context of what was reasonable based on the subject matter as a whole as would have been understood at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. The descriptions in the reference are not obfuscated by the numerous other suggested usages of said description in the reference. In addition, implicitly, impliedly and inferentially, various functions locations are taught and language identical or verbatim is not required in an obvious rejection. Note that reasonable “inferences”, and “common sense” may be considered in formulating rejections for obviousness. Specifically, *In re Preda*, 401 F.2d 825, 159 USPQ 342, 344 (CCPA 1968) states “in considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” Also, *In re Bozek*, 416 F.2d 738, 163 USPQ 545, 549 (CCPA 1969) states that obviousness may be concluded from “common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference”. Additionally, see *In re Gauerke*, 24 CCPA 725, 86 F.2d 330, 31 USPQ 330, 333 (CCPA 1936), and *In re Libby*, 45 CCPA 944, 255 F.2d 412, 118 USPQ 94, 96 (CCPA 1958), and *In re Jacoby*, 309 F.2d 738, 125 USPQ 317, 319 (CCPA 1962), and *In re Wiggins*, 488 F.2d 538, 543, 1979 USPQ 421, 424 (CCPA 1973). Thus, Applicant's arguments can not be held as persuasive regarding patentability.

10. Applicant suggests “a presentation page ... is presented if the full check is successful”, Paper dated June 30, 2004, Page 9, lines 2-4 is not taught in Puri. Thus, applicant suggests a “presentation page” is made when the customer’s needs or configuration choice is not met.

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Inherently, the presentation page is made after the customer's selection is checked for viability or success. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

Conclusion


1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is disclosed in the Notice of References Cited. A close review of the Ross reference with Patent Number 6,389,506 and Vu with US Patent Number 5,623,601 is suggested. The other references cited teach numerous other ways to inhibit routing to a network unless the network is part of the IP address, thus a close review of them is suggested.
2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
3. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (703) 308-5230. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.
5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.
6. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9605.

sfw

September 24, 2004


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER